



Docket No.: 04280/1201643-US2  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*In re* Patent Application of:  
Nils Lonberg *et al.*

Application No.: 08/728,463

Confirmation No.: 2701

Filed: October 10, 1996

Art Unit: 1644

For: TRANSGENIC NON-HUMAN ANIMALS FOR  
PRODUCING HETEROLOGOUS  
ANTIBODIES

Examiner: P. J. Nolan

## **REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR §1.48(a)**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

Applicants respectfully request correction of the inventorship of the above-identified non-provisional patent application. The inventive entity originally identified in the above-identified application as Nils Lonberg and Robert Kay was in error. The the actual inventive entity of the present invention is Nils Lonberg, Robert Kay, and Dianne M. Fishwild. The error in naming the original inventive entity arose without any deceptive intention on the part of Dianne M. Fishwild who through an inadvertent error was not named as an inventor. As required under 37 C.F.R. §1.48(a), this request is accompanied by:

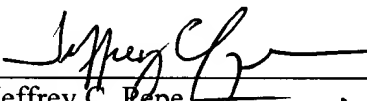
- (a) Statement of Dianne M. Fishwild, stating that the error in inventorship in the above-identified application arose through error and without deceptive intention on her part;

- (b) Consent of Assignee from an authorized officer for GenPharm International, Inc., the current assignee of this application, consenting to the change of inventorship, including Statement under 37 C.F.R. § 3.73(b);
- (c) Declaration by Nils Lonberg, Robert Kay, and Dianne M. Fishwild as required under 37 C.F.R. §1.63;
- (d) Copy of Assignment from Dianne M. Fishwild to GenPharm International, Inc.; and
- (e) Processing fee of \$130.00 required under 37 C.F.R. §1.17(i) in the form of a check. (The Commissioner is authorized to charge any deficiency or credit any excess in this fee to Deposit Account No. 04-0100.)

Applicants respectfully request correction of the inventorship and the issuance of a Corrected Filing Receipt listing all inventors.

Respectfully submitted,

Dated: May 16, 2005

By   
Jeffrey C. Pepe  
Registration No.: 46,985

DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(206) 262-8900  
(212) 527-7701 (Fax)  
Attorneys/Agents For Applicant

Enclosures as noted



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Nils Lonberg and Robert M. Kay

Application No.: 08/728,463

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For: TRANSGENIC NON-HUMAN ANIMALS FOR  
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Examiner: P. J. Nolan

**DECLARATION OF NILS LONBERG, ROBERT M. KAY AND DIANNE M. FISHWILD**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

We, Nils Lonberg, Robert M. Kay and Dianne M. Fishwild, declare and state that:

1. We are the joint inventors in the above-identified patent application.
2. We are co-authors, along with Susan L. O'Donnell, Tasha Bengoechea, Debra V. Hudson, Fiona Harding, Susan L. Bernhard, Debbie Jones, Kay M. Higgins and Stephen R. Schramm, of the article entitled "High-avidity human IgGκ

monoclonal antibodies from a novel strain of minilocus transgenic mice,” *Nature Biotechnology* 14:845-851, July 1996 (hereinafter “Fishwild *et al.* article”).

3. We are familiar with the development of the subject matter described in the Fishwild *et al.* article.
4. In our laboratory under our direction and supervision, Susan L. O'Donnell, Tasha Bengoechea, Debra V. Hudson, Fiona Harding, Susan L. Bernhard, Debbie Jones, Kay M. Higgins and Stephen R. Schramm, assisted in experiments associated with the Fishwild *et al.* article.
5. As a result of the participation and capacities recited in paragraph 4 above, the substance of the Fishwild *et al.* article was the work of only us.
6. We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of any patent issuing from this patent application.

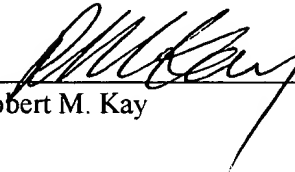
Dated this 28<sup>th</sup> day of April, 2005.

  
\_\_\_\_\_  
Nils Lonberg

Declaration of Lonberg, Kay and Fishwild  
Application No.: 08/728,463

Docket No.: 04280/1201643-US2

Dated this 19<sup>th</sup> day of April, 2005.

  
\_\_\_\_\_  
Robert M. Kay

Dated this \_\_\_\_\_ day of \_\_\_\_\_, 2005.

\_\_\_\_\_  
Dianne M. Fishwild

DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(206) 262-8900  
(212) 753-6237 (Fax)  
Attorneys/Agents For Applicant

80020816

Declaration of Lonberg, Kay and Fishwild  
Application No.: 08/728,463

Docket No.: 04280/1201643-US2

Dated this \_\_\_\_\_ day of \_\_\_\_\_, 2005.

\_\_\_\_\_  
Robert M. Kay

Dated this 16<sup>th</sup> day of May, 2005.

Dianne M. Fishwild  
Dianne M. Fishwild

DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(206) 262-8900  
(212) 753-6237 (Fax)  
Attorneys/Agents For Applicant

80020816



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Nils Lonberg et al.

Application No.: 08/728,463

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PRODUCING HETEROLOGOUS  
ANTIBODIES

Examiner: P. J. Nolan

STATEMENT OF DIANNE M. FISHWILD

I, Dianne M. Fishwild, declare that I am a joint inventor of an invention entitled "TRANSGENIC NON-HUMAN ANIMALS FOR PRODUCING HETEROLOGOUS ANTIBODIES," as described and claimed in the specification and claims of U.S. Patent Application No. 08/728,463, which was filed in the U.S. patent and Trademark Office on October 10, 1996.

I declare that the error in inventorship in the above-identified application occurred without any deceptive intention on my part.

5/8 5/7/05  
Date DMF

Dianne M. Fishwild  
Dianne M. Fishwild  
Fishwild DMF

State of CALIFORNIA )  
County of SANTA CLARA )

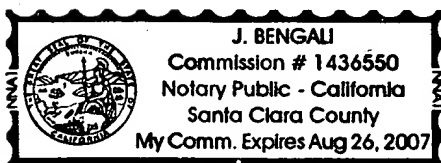
I certify that I know or have satisfactory evidence that Dianne M. Fishwild is the person who appeared before me, and said person acknowledged that she signed this instrument and acknowledged it to be her free and voluntary act for the uses and purposes metioned in the instrument.

Dated: 5/9/05

Signature of Notary Public: Bengali

Printed Name: J. BENGALI

My appointment expires: Aug 26, 2007





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Examiner: P. J. Nolan

**CONSENT OF ASSIGNEE AND STATEMENT UNDER 37 C.F.R. § 3.73(b) FOR  
REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)**

GenPharm International, Inc. hereby consents to the correction of the inventorship of the above-referenced patent application to add inventor Dianne M. Fishwild as co-inventor with Nils Longberg and Robert Kay, as requested in the Request to Correct Inventorship under 37 C.F.R. § 1.48(a) and filed herewith.

The undersigned hereby declares that GenPharm International, Inc., a corporation, is the assignee of the entire right, title, and interest in the patent application identified above by virtue of a chain of title from the inventors of the patent application identified above, to the current assignee, as shown below:

(1) From: Nils Lonberg and Robert Kay, To: GenPharm International, Inc.

The document was recorded in the United States Patent and Trademark Office on March 24, 1997 at Reel 8418, Frame 0102;

(2) From: Dianne M. Fishwild, To: GenPharm International, Inc. A copy of this document is attached.



Consent of Assignee  
Application No. 08/728,463

Docket No. 04280/1201643-US2

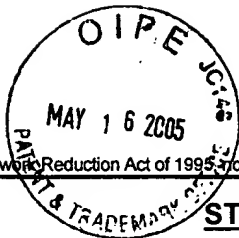
The undersigned (whose title is supplied below) is authorized to act on behalf of  
the assignee.

GenPharm International, Inc.

5/13/05  
Date

W. Bradford Middlekauff  
By: W. Bradford Middlekauff  
Its: Senior Vice President and General Counsel  
Title  
Telephone Number: 609-430-2880

80025591

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: Nils Lonberg et al.Application No./Patent No.: 08/728,463Filed/Issue Date: October 10, 1996Entitled: TRANSGENIC NON-HUMAN ANIMALS FOR PRODUCING HETEROLOGOUS ANTIBODIESGenPharm International, Inc.  
(Name of Assignee)

, a

corporation

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or2. ☐ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

in the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 8418, Frame 0102, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

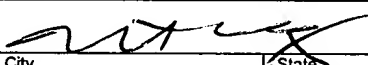
The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

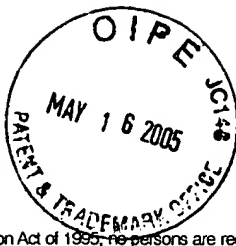
11/17/04  
Date609-430-2880  
Telephone NumberW. Bradford Middlekauff  
Typed or printed nameW. Bradford Middlekauff  
SignatureSenior Vice President & General Counsel  
Title



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**DECLARATION — Utility Patent Application**

Direct all correspondence to: <input checked="" type="checkbox"/> The address associated with Customer Number:		07278		OR <input type="checkbox"/> Correspondence address below	
Name					
Address					
City			State		ZIP
Country		Telephone		Fax	
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.					
NAME OF SOLE OR FIRST INVENTOR:			<input type="checkbox"/> A petition has been filed for this unsigned inventor		
Given Name (first and middle (if any))			Family Name or Surname		
Nils			Lonberg		
Inventor's Signature			Date		
			04-28-05		
Residence: City		State	Country		Citizenship
Woodside		CA	United States of America		US
Mailing Address:	168 Bardet Road				
City		State	ZIP	Country	
Woodside		CA	94062	United States of America	
NAME OF SECOND INVENTOR:			<input type="checkbox"/> A petition has been filed for this unsigned inventor		
Given Name (first and middle (if any))			Family Name or Surname		
Robert M.			Kay		
Inventor's Signature			Date		
Residence: City			State	Country	
San Francisco			CA	United States of America	
Mailing Address:	2127 Broadway #5				
City		State	ZIP	Country	
San Francisco		CA	94115	United States of America	
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on the <u>1</u> supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.					



PTO/SB/01 (09-04)  
Approved for use through 07/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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## DECLARATION — Utility Patent Application

Direct all correspondence to: ☒ The address associated with Customer Number: **07278** OR ☐ Correspondence address below

Name

Address

City

State

ZIP

Country

Telephone

Fax

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name  
(first and middle (if any))

Nils

Family Name  
or Surname

Lonberg

Inventor's  
Signature

Date

Residence: City

Woodside

State

CA

Country

United States of America

Citizenship

US

Mailing  
Address:

168 Bardet Road

City

Woodside

State

CA

ZIP

94062

Country

United States of America

NAME OF SECOND INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name  
(first and middle (if any))

Robert M.

Family Name  
or Surname

Kay

Inventor's  
Signature

Date

4/19/05

Residence: City

San Francisco

State

CA

Country

United States of America

Citizenship

US

Mailing  
Address:

2127 Broadway #5

City

San Francisco

State

CA

ZIP

94115

Country

United States of America

☒

Additional inventors or a legal representative are being named on the 1 supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.



PTO/SB/02A (09-04)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>DECLARATION</b>	<b>ADDITIONAL INVENTOR(S)</b> Supplemental Sheet
Page 1 of 1	

<b>Name of Additional Joint Inventor, if any:</b>		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Dianne M.		Fishwild	
Inventor's Signature <i>Dianne M. Fishwild</i>		Date <i>5/8/05</i>	
Residence: City	State	Country	Citizenship
Mountain View	CA	United States of America	US
Mailing Address: 1012 Varsity Court			
City	State	Zip	Country
Mountain View	CA	94040	United States of America
<b>Name of Additional Joint Inventor, if any:</b>		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address:			
City	State	Zip	Country
<b>Name of Additional Joint Inventor, if any:</b>		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address:			
City	State	Zip	Country
<b>Name of Additional Joint Inventor, if any:</b>		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address:			
City	State	Zip	Country

{S:\04280\1201643-us2\80026035.DOC }  
\*\*\*\*\*

## ASSIGNMENT

I, Dianne M. Fishwild, a citizen of the United States of America, residing at 1012 Varsity Court, Mountain View, California 94040 (hereinafter "ASSIGNOR"); along with Nils Lonberg and Robert Kay; in consideration of good and valuable consideration, the sufficiency of which and receipt of which are hereby acknowledged, paid to ASSIGNOR by

GenPharm International, Inc.

a corporation organized under the laws of California, located at 521 Cottonwood Drive, Milpitas, California 95035 (hereinafter "ASSIGNEE"), do hereby sell and assign to said ASSIGNEE, its successors and assigns, the below indicated right, title, and interest, throughout the world in and to my Invention entitled:

### TRANSGENIC NON-HUMAN ANIMALS FOR PRODUCING HETEROLOGOUS ANTIBODIES

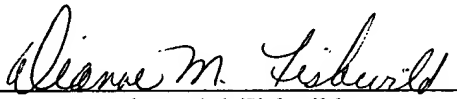
invented by us and described in Patent Application No. 08/728,463, filed on October 10, 1996, in United States of America; and all patents, divisions, reissues, continuations and any extensions thereof and rights of priority therein, said interest being my entire ownership interest in the same, to be held and enjoyed by said ASSIGNEE, its successors, assigns, or other legal representatives, to the full end of the term thereof, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not be made;

And for the consideration aforesaid, I hereby covenant and agree to and with said ASSIGNEE, its successors and assigns, that whenever ASSIGNEE, its counsel or representative, or the counsel or representative of its successors or assigns, shall advise that an amendment to, or a division of, or any other proceeding or action in connection with an application concerning said Invention, including interference proceedings, is lawful and desirable, or that a reissue or continuation or extension of such application or patent issuing therefrom is lawful and desirable, I will sign all papers and drawings, take all rightful oaths and affidavits, and do all acts necessary or required to be done for the procurement of all lawful rights associated with the Invention, or for the reissue or continuation or extension of the same, will do all acts necessary or required to secure in said ASSIGNEE, its successors or assigns, the title to and full benefit of all rights hereby assigned, without charge to said ASSIGNEE or its

successors or assigns, but at its or their expense; and I hereby appoint every present or future officer of said ASSIGNEE as my agent to sign all such papers and to do all such necessary acts on my behalf, to the fullest extent permitted by law;

And I hereby authorize and request the Commission of Patents and Trademarks and any other granting authority to issue any Letters Patent resulting from said Invention and application(s) concerning same to said ASSIGNEE.

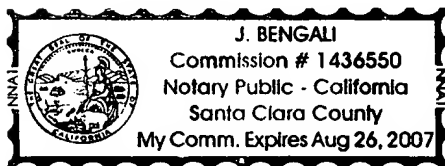
I declare under penalty of perjury under the laws of the United States of America, and under penalty of the laws of any other jurisdiction before which this document may be presented, that I have signed this document as my own free act and that all of the foregoing is true and correct.

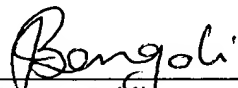
  
Dianne M. Fishwild

Date: 5/7/05

United States of America )  
State of CALIFORNIA ) ss.:  
County of SANTA CLARA )

On this 7<sup>TH</sup> day of May, 2005, before me personally came Dianne M. Fishwild, to me known to be the individual described in and who executed the foregoing instrument, and acknowledged execution of the same.



  
Notary Public